

REMARKS

Claims 15-22, 37-41, and 50-53 are all the claims pending in the application.

Claims 17, 18, 21, 37-41 and 50-53 are withdrawn from consideration.

Claims 15, 16, 19, 20 and 22 are rejected.

Claims 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Takashi et al. (JP 08-187868).

Claims 15 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Morikoshi et al. (U.S. Patent No. 5,684,520).

Claims 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takashi et al. in view of Otsuka et al. (U.S. Patent No. 6,305,792).

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikoshi et al. in view of Otsuka et al. (U.S. Patent No. 6,305,792).

The Applicants traverse the rejections and request reconsideration.

Claim 15 has been amended to include limitations from present claim 16. This renders moot all the rejections except for the section 102 rejection based on Takashi.

The patent office maintains that Takashi et al. teaches a process comprising first and second etching steps for etching both surfaces of a plate-shaped member as shown in Fig. 2 thereof. However, Takashi et al. **does not disclose an etched partition wall**. In the ink jet recording head disclosed by Takashi et al. only the island part 9, that is disposed on one side of the polymer film 8, is an etched structure. The patent office incorrectly contends that the spacer 3 (i.e., alleged partition wall) which is disposed on the other side of the polymer film 8, is an

etched structure. The Applicants respectfully submit that the spacer 3 is not an etched structure. The Applicants reiterate that pressure chamber 4 is tapered. On the other hand, as shown in Fig. 2 of Takashi, the vertical line of the section of the reservoir 6 is not tapered. A skilled artisan would know that it is technically impossible to form both tapered vertical line and non-tapered vertical line using the same etching process.

Importantly Takshi does not disclose a first etching step for etching the plate-shaped member to form the partition wall on the front surface of the plate-shaped member. It does not disclose a second etching step for etching the plate-shaped member to form the land on the back surface of the plate-shaped member. Further, it does not disclose that the first etching step etches a desired portion of the first layer selectively- over the intermediate layer so that the first layer is penetrated. Still further, it does not disclose that the second etching step etches a desired portion of the second layer selectively over the intermediate layer so that the second layer is penetrated.

The patent office contends that the partition wall is formed **inherently** by etching or removing portions of the plate shaped member to produce a plate shaped member.

It appears that the patent office incorrectly applies the law of inherency to the current situation. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. MPEP 2112 *citing In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Applicants respectfully submit that a skilled artisan, reading Takashi, would not have recognized that the partition wall is formed by etching.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No.: 10/786,331

Attorney Docket No.: Q80114

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Takashi and Morikoshi do not anticipate (or suggest) the present invention at least because of the significant structural differences noted above.

Claims 19, 20 and 22 are dependent on claim 15 and are allowable for the same reasons.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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